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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/011,634	04/03/1998	MARC ARONHIME	P16370	1164

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EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/011,634

Applicant(s)

ARONHIME ET AL.

Examiner

Michael E. Grendzynski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-45 and 66-82 is/are pending in the application.
- 4a) Of the above claim(s) 77-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-45, 66-76 and 80-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 29.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The arguments filed on 1/3/03 have been carefully considered by not found persuasive.

Specification

2. The amendment filed 12/18/01 remains objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. See the explanation with regard to the 35 U.S.C. 112, first paragraph rejection, below (§ 3). Applicants are required to cancel the new matter in the reply to this Office Action

Claim Rejections - 35 USC § 112

3. Claims 29-45 and 66-76 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. First, the claim language does not exclude the presence of tackifiers in the release layer. Second, it is not inherent that the claimed release layer formulations are non-tacky. Applicants argue that the release coating of the instant invention is inherently non-tacky, and this inherency is shown by the declaration of Dr. Aronhime. The examiner has carefully considered the declaration of Dr. Aronhime (Paper No. 31); however, the declaration does not evidence the inherency of a non-tacky property in the claimed release layer formulations. Applicants argue that the experiments referenced in the declaration conclusively prove that "any blankets as manufactured using the recipes set forth in the disclosure are non-tacky." The declaration, however,

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fails to disclose the recipe used by applicants in forming the transfer blanket. Second, assuming, *arguendo*, that the exact recipes of the representative examples were used (specification pp 22-24); the exemplary formulations still remain unclear. The declaration, in ¶ 4, refers to the examples described in the specification on pp 21-24 as those being used base formulations for the release layer. These pages, however, provide two possible formulations. The results. It is not apparent from the declaration which formulation was used.¹ Third, assuming one specific base formulation was used, the claims are not commensurate in scope with the evidence. That is, the claims do not provide for the particular components present in the specific amounts as disclosed in the formulations on pages 21-24 of the specification. Fourth, the declaration does not evidence that the claimed formulations are non-tacky because the experiments were performed using liquid toner imaging process, but the claim language includes not only liquid toner imaging processes, but also powder toner imaging processes. The declaration of Paper No. 31 states, “under normal conditions of operation, i.e., at room temperature and at the temperatures normally encountered in liquid toner imaging . . . the surface of the blanket is not tacky.” Declaration, p 2, ¶ 8. Applicants, however, are not claiming a medium used only in liquid toner imaging processes.² Once the claims are read in light of the specification, it is clear that the blankets may also be used in powder systems. *See* specification, p 28. Consequently, it does not necessarily flow that the claimed release layer remains non-tacky under conditions outside of “normal liquid toner imaging” processes. For these reasons, the declaration of Paper No. 31 does not provide the requisite evidence that the release layer of the instant invention is non-tacky.

Applicant is required to cancel the new matter in the reply to this Office Action.

¹ The declaration provides a comparison using only one of the base formulations.

² It is appreciated that claim 76 requires the medium to be suitable for liquid toner reception. As made of record, since the Namiki article discloses all of applicants’ compositional and positional limitations, it is inherent the article possesses this property.

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4. Claim 76 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Currently, the property of the layer is unclear. Is the “further surface” same as the second surface of claim 29? Is the liquid toner transferred from a first surface? Clarification is requested.

Claim Rejections - 35 USC § 102

5. Claims 29-44, 66-74 and 76 remain rejected under 35 U.S.C. 102(b) as being anticipated by Namiki (Ricoh Co) (JP- 57-19753) for the reasons of record. Applicants argue that (1) Namiki does not teach the combination of tackifying silicone oil with a condensation type silicone material and (2) Namiki does not teach that the silicone oil is a tackifying agent for condensation cured silicone rubber. As made of record, Namiki discloses a transfer member comprising a substrate and a layer of silicone rubber (also called a tacky layer). *See* Translation, pp 1-3. The layer of silicone rubber comprises a condensation-cured diorganopolysiloxane. *See id.* *See also*, Translation, p 9. A diorganopolysiloxane is the *identical* condensation cured silicone used by applicants, as disclosed on p 22 of the specification.

The first argument is not found persuasive because applicants’ argument is not commensurate in scope with the claims. The fact that Namiki does not disclose a combination of silicone oil with a condensation-cured diorganopolysiloxane does not distinguish the instant invention over the prior art—none of the claims at issue *require* such a combination. Namiki, moreover, discloses an embodiment whereby the layer of silicone rubber (the tacky layer) comprises (1) a 2-pack raw silicone, (2) a hardener, (3) a tackifier comprising a condensation-cured diorganopolysiloxane and, optionally, (4) an adjusting agent comprising silicone oil (i.e., a silicone oil having a viscosity or less than 10,000). *See* Claim 1 and p 14 of the Translation.

Similarly, the second argument is not found persuasive because whether the silicone oil acts as a tackifying agent for the condensation-cured silicone is not dispositive on the issue of patentability. None of the claims at issue require the presence of silicone oil (regardless of the viscosity range).

Applicants further argue that the examiner has relied upon a type of silicone oil that is not relevant to the present invention. This argument is not understood. The specification does not differentiate between tackifying silicone oils and non-tackifying silicone oils. The claims, moreover, do not require the existence of *either* type of oil in the release layer. In addition, Paper No. 4, ¶ 12 makes clear that Namiki discloses an embodiment wherein the silicone rubber layer comprises (1) a 2-pack raw silicone, (2) a hardener, (3) a tackifier comprising a condensation-cured diorganopolysiloxane and, optionally, (4) an adjusting agent comprising silicone oil (i.e., a silicone oil having a viscosity or less than 10,000). That is, the Namiki layer comprises applicants' condensation-cured silicone and, optionally, silicone oil that, as indicated by applicants, does not affect the tackiness of the layer. The examiner cannot discern a compositional difference between the inventive release layer and the Namiki silicone rubber layer.

Examiner appreciates that Namiki denotes his layer of silicone rubber as a "tacky" layer. Applicants have attempted to avoid the prior art by amending the claim to indicate that the release layer of the instant invention is a non-tacky layer. The Namiki layer of silicone rubber, however, comprises applicants' *identical* components present in *identical* amounts. Consequently, it is *inherent* that the layer possesses the claimed non-tacky property. *In re Swinehart et al.*, 169 USPQ 226 at 229. It is also inherent that both layers--the Namiki layer of silicone rubber and the inventive release layer--possess a certain degree of tackiness. The specification does not provide guidance as to what degree of adherence makes one transfer blanket "tacky" and another "non-tacky."

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The burden is upon the “applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon.” To date, this burden has not been sustained. It is suggested that applicants provide evidence showing the tackiness levels of the instant invention differ from the tackiness levels of the Namiki medium.

6. For similar reasons, claims 29, 39-41 and 76 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryoichi (JP 57-020742) for the reasons of record. Examiner acknowledges applicants’ confusion regarding the application of this reference. As made of record, the abstract clearly discloses a medium comprising transfer layer comprising a condensation-cured silicone. The application of this reference, consequently, is appropriate.

7. Claims 29-33, 35-41 and 76 remain rejected under 35 U.S.C. 102(b) as being anticipated by Wang (US 5114520) for the reasons of record. Applicants argue that since an intermediate transfer member suitable for the transfer of images must have a special construction to operate, the medium of Wang would not anticipate the claims of the instant invention. This argument is not found persuasive. Wang comprises applicants’ identical components present in identical amounts; consequently, it is inherent the medium functions in the manner claimed by applicants. Applicants, while referring to a special construction of a transferring member, do not claim a particular structure. The claims at issue are to a substrate with a layer comprising a condensation-cured silicone thereon. Wang discloses just such an article.

8. Claims 80-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Namiki (Ricoh Co) (JP- 57-19753) (Translation provided by applicants). Applicants claim an image transfer member suitable for the receiving of toner images from a first surface and their transfer to a second surface comprising a base layer and an outer release layer including a condensation cured silicone and less than 4% filler material. Namiki (Ricoh Co) discloses a transfer member comprising a substrate and a

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layer of silicone rubber. *See* Translation, pp 2-3 and p 15. The layer of silicone rubber is equivalent to applicants' release coating—it comprises a condensation-cured silicone. *See* Translation, pp 1-3 and p 9. The layer of silicone rubber further comprises a cross-linking agent and, *optionally*, fillers. *See* Translation, p 4. That is, the layer does not require that fillers be present in the medium. This is equivalent to applicants' value for a filler material of less than 4%. The phrase "less than 4%," inherently includes 0%. The layer of silicone rubber, moreover, possesses a thickness value within the value claimed by applicants (5 μm or more). *See* Translation, p 15. The Namiki article is a transfer blanket—an image is placed on the tacky layer (i.e., from a first surface), and then transferred to another surface (i.e., a second surface). *See* Translation at p 2-3. In addition, "it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Namiki (Ricoh Co.) member teaches all of applicants' claimed compositional and positional limitations, it is inherent that the member functions in the manner claimed by applicants. That is, since the member comprises all of applicants' claimed components in the same amounts as claimed by applicants (e.g., a layer comprising condensation cured silicone and no filler material), it is inherent that the member functions in the manner claimed by applicants, i.e., that it possesses the ability to receive and image from a first surface and transfer the image to a second surface. The burden is upon the "applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon." To date, this burden has not been sustained.

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Conclusion

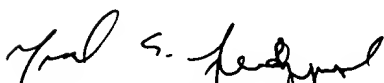
9. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

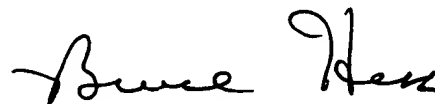
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.


Michael E. Grendzynski
Assistant Examiner
March 10, 2003



BRUCE H. HESS
PRIMARY EXAMINER